

DOCKET NO.: 209466US6PCT/jkl



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF:

GROUP: 2164

Ryuji ISHIGURO, et al.

SERIAL NO: 09/869,164

EXAMINER: Al Hashemi, S.A.

FILED: June 25, 2001

FOR: CONTENTS DATA MANAGEMENT METHOD

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.


This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

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IN RE APPLICATION OF :  
RYUJI ISHIGURO, ET AL. : EXAMINER: AL HASHEMI, SANA A  
SERIAL NO: 09/869,164 :  
FILED: JUNE 25, 2001 : GROUP ART UNIT: 2164  
FOR: CONTENTS DATA :  
MANAGEMENT METHOD :

REMARKS ACCOMPANYING  
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

FAILURE TO ESTABLISH A PRIMA FACIE CASE OF ANTICIPATION

Applicants submit that the Official Action of November 14, 2005 and the Advisory Action of February 22, 2006 have failed to provide a *prima facie* case of anticipation with respect to Claims 1-3 and 19-33.<sup>1</sup>

Pending Claims 1-3 and 19-33 stand rejected under 35 U.S.C. §102 in view of Benson.

Applicants Claim 1 recites, *inter alia*, "...the using condition information indicating usage rules corresponding to the content data; means for converting said first format of said

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<sup>1</sup> See Official Action of November 14, 2005 detailing the rejections of Claims 1-3 and 19-33 under 35 U.S.C. §102(b) as anticipated by Benson et al. (U.S. Patent No. 5,845,281, hereinafter Benson)

using condition information into a second format, said format being different from the first format.”

Claim 1 specifically requires that the format of the using condition information be converted. The outstanding Office Action in the Response to Arguments section states “Benson discloses a means for converting format,”<sup>2</sup> and the Advisory Action States “Benson discloses the method of converting a format.”<sup>3</sup> However, Claim 1 does not merely require only a means or method for converting format. Claim 1 recites “means for converting said first format of said *using condition information* into a second format.” Benson does not describe or suggest converting the first format of the *using condition information* into a second format, different from the first format.

The required analysis of the Claim 1 recited “means for converting” and associated functionality has not been performed. In this regard, the PTO reviewing court recently emphasized that conclusory findings that omit analysis as to “means” claim limitations are improper in Gechter v. Davidson 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) as follows:

In addition, the [PTO] never construed the scope of the structures disclosed in the specification for the claimed “receiving means,” nor did the [PTO] expressly find that the “receiving means” disclosed in the specification was structurally equivalent to that embodied in [the reference]. Moreover, the [PTO] also failed to define the exact function of the receiving means, as well as to find that [the reference] disclosed the identical function. (Emphasis added, citation omitted.)

A. IDENTICAL FUNCTIONALITY IS NOT IDENTIFIED

Applicants respectfully submit that it is improper to merely interpret the above-quoted claimed language as “converting format” as is done in the outstanding Official Action and in the Advisory Action. None of the words of Claim 1 can be ignored. See In re Wilson, 165

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<sup>2</sup> Office Action, November 14, 2005, page 4, Response to Arguments.

<sup>3</sup> Advisory Action, continuation of note 3.

USPQ 494, 496 (CCPA 1975) which states “All words in a claim must be considered in judging the patentability of that claim against the prior art.”

B. CONVERSION OF DATA OBJECTS DOES NOT MEET CLAIM LIMITATIONS

The outstanding Official Action and the Advisory action rely on Fig. 4, block 409 to support the pending rejection. Block 409 merely states “data object conversion.” The outstanding Office Action and Advisory Action rely on Col. 6, lines 40-48 of Benson, which merely discloses that format modules 306 can convert the format of *data objects*. The outstanding Office Action and Advisory Action rely on Col. 7, lines 53-59 of Benson, which does not address using condition information. Col. 7, lines 53-59 merely discloses “...specifying any format module to be used for converting the format of the *data object*...” (emphasis added).

The data object is not the using condition information. The data object does not include using condition information indicating usage rules corresponding to the *permitted use of the data object*, as is recited in Claim 1.

Benson itself establishes that the conditions for usage 42 and the data object 24 are different. Conditions for usage 42, or the usage data file, represent conditions for the use of data object 24.<sup>4</sup> The usage information may comprise “the kind of user who is authorized to use the data object, the price for different usages of the object etc.”<sup>5</sup>

The outstanding Office Action also relies on Benson’s disclosure of converting the format of the *data object*, which is different from “using condition information” as discussed above. Benson does not describe or suggest converting the format of conditions for usage 42 into a second format, different from a first format.

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<sup>4</sup> Benson, col. 7, lines 15-18.

<sup>5</sup> Benson, col. 7, lines 64-66.

Furthermore, Fig. 14, item 1406 only refers to a format module. Format module 1406 includes program code that is necessary to handle *data objects* in their native format. Benson does not describe or suggest that format module 1406 converts the first format of the *using condition information* into a second format.

In a data packaging program, the format modules are used to convert the format of the data object into a format required by content providers, such as from BMP files to GIF files, *but not to convert the format of usage conditions*.<sup>6</sup>

Moreover, the outstanding Office Action relies on Benson's disclosure of "program 35 never stores the *object data* in native format in user accessible storage" (emphasis added) to support the position that Benson discloses the claimed "means for converting said first format of said using condition information into second format."<sup>7</sup> Benson, by its own admission, is only converting the format of the data object. In user program 35, the usage manager module uses a data object by applying the format of the data object used in the corresponding data packaging program.<sup>8</sup> Benson does not convert the format of the *using condition information* from a first format to a second format.

Benson only discloses that the data packaging program converts the format of the *data object (not the usage conditions)* based on specified format code.<sup>9</sup> Converting the format of the *data object* does not describe or suggest the claimed "means for converting said first format of said *using condition information* into a second format, said second format being different from the first format" (emphasis added). The data object is different than the usage conditions as established above.

As such, there is no analysis by the Patent and Trademark Office as to how the completely dissimilar function of converting format of a data object can be said to be

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<sup>6</sup> Benson, col. 6, lines 40-43, col. 7, lines 58-59, and col. 8, lines 12-14.

<sup>7</sup> Office Action, November 14, 2005, page 4-5.

<sup>8</sup> Benson, col. 11, 50-56.

<sup>9</sup> Benson, col. 6, lines 40-43, col. 7, lines 54-64, and 409 of Fig. 4.

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structurally equivalent to the Claim 1 means and corresponding functionality of “means for converting said first format of said using condition information into a second format....”

*Gechter* requires an explanation of how the Benson functions disclosed at the relied upon sections, are identical to the functions claimed. As noted above in *Gechter*, this identical function must be found in the reference to anticipate the Applicants’ claims

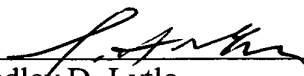
Thus, Benson does not disclose or suggest the claimed “means for *converting said first format of said using condition information into a second format*, said format being different from the first format” (emphasis added).

#### CONCLUSION

Based on this clear legal deficiency in the above-noted rejection, Applicants respectfully request that prosecution be re-opened as the current grounds of rejection have not been clearly development to such an extent that the Applicants can readily judge the Examiner’s position or the advisability of preparing a traditional Appeal Brief.

Respectfully submitted,

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